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In re Application of
ALLEN et al.
Application No.: 09/857,522
PCT No.: PCT/US99/29824
Int. Filing Date: 15 December 1999
Priority Date: 16 December 1998
Attorney Docket No.: BB1315
For: PLANT CARBON CATABOLITE
REPRESSION PROTEINS

DECISION ON PETITION
UNDER 37 CFR 1.137(a)

This is a decision on applicants' "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVIDABLY UNDER 37 CFR 1.137(a)" filed in the Patent and Trademark Office (PTO) on 18 March 2002.

BACKGROUND

On 15 December 1999, applicants filed international application no. PCT/US99/29824 which claimed a priority date of 16 December 1998. A Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 16 June 2001.

On 04 June 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee and a declaration of inventors.

On 27 July 2001, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENT UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) and a NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES (Form PCT/DO/EO/920) indicating that applicant had not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. Furthermore, the Notification stated that the sequence listing was not in compliance with 37 CFR 1.821-1.825 in that a copy of the "sequence listing" in a computer readable form had not been submitted as required by 37 CFR 1.821(e).

On 27 September 2001, applicants filed "Statement under 37 CFR 1.821(g) and 1.825(b)" which included a substitute computer readable form of the "Sequence Listing."

On 31 December 2001, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating that the "nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reasons: A copy of the 'Sequence Listing' in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of 37 CFR 1.822 and/or 1.832, as indicated on the attached marked up copy of the 'Raw Sequence Listing.'"

On 31 January 2002, the above identified application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 27 July 2001 within the time period set therein.

On 18 March 2002, applicant filed the present petition. Applicants state in the present petition, "the notification of defective response was not received . . . until February 15, 2002."

DISCUSSION

A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the requisite petition fee; (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 1.20(d)) required pursuant to 37 CFR 1.137(c). Applicants have satisfied Item (2) and (4).

With regard to Item (1), the proper response is the required sequence listing pursuant to 37 CFR 1.821-1.825. The computer readable form accompanying the present petition was not readable. (See attached copy of CRF Problem Report.) Accordingly, the proper reply has not been furnished.

As to Item (2), the appropriate petition fee of \$110.00 is required pursuant to 37 CFR 1.17(m).

With regards to item(3), applicants have not provided an acceptable showing that the delay was unavoidable. Applicants argue in their petition that the "receipt of the Notification of Defective Response (February 15, 2002) occurred after the time limit for responding to the Notification of Defective Response expired (January 31, 2002) and, thus, the application became abandoned for failure to respond." Applicants' assertion is incorrect. As stated above, a proper response to the Notice of Missing Requirements mailed 27 July 2001 was due by 27 September 2001 which was extendable up to maximum of five months, 27 February 2002. Therefore, applicants could have filed a proper response through 27 February 2002 under 37 CFR 1.136(a). Alternatively, applicants could have timely petitioned to reset the period of reply set in the Notification of Defective Response. See

MPEP 710.06. Thus, it is clear from the facts of record that the abandonment of the instant application was not unavoidable.

A petition to revive an application under 37 CFR 1.137(a) cannot be granted where a petitioner has failed to meet his burden of establishing unavoidable delay within the meaning of 37 CFR 1.137(a) and 35 U.S.C. 133. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987). Therefore, since applicants have not satisfied item (1) and (3) above, the granting of the petition under 37 CFR 1.137(a) for revival based on unavoidable delay would not be proper.

CONCLUSION

The petition under 37 CFR 1.137(a) is **DISMISSED** without prejudice and the application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, an appropriate response to this decision must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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Enclosure: CRF Problem Report dated 28 March 2002